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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/749,141	12/30/2003	John D. Mata	127P105USU1	3840

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IPLM GROUP, P.A.
POST OFFICE BOX 18455
MINNEAPOLIS, MN 55418

EXAMINER	
NGUYEN, DINH Q	
ART UNIT	PAPER NUMBER
3752	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/749,141	MATA ET AL.	
	Examiner	Art Unit	
	Dinh Q. Nguyen	3752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 April 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-17* is/are pending in the application.

4a) Of the above claim(s) *6,9,10,16 and 17* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5,7,8 and 11-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-5, 7-8, 11-15 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Evidence that claims 1-5, 7-8, 11-15 fail(s) to correspond in scope with that which applicant(s) regard as the invention can be found in the reply filed on April 24, 2009. In that paper, applicant added newly limitation "extruding a bead of material on the substrate", and this limitation indicates that the invention is different from what is described in the specification because on page 4, there are three different reference numbers 17, 20 and 23 are using to describe "a bead of material"; furthermore, the bead material is extruded on top of the substrate 20 as shown in figure 2, is similar to the process of the Harrold '634 at the station D.

3. For the purpose of this Office action, the claims will be examined as best understood by the examiner.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir.

1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-5, 7, 8, 11-15 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 5-10 of copending Application No. 11/668,768. Although the conflicting claims are not identical, they are not patentably distinct from each other because of common subject matter, as follows;

Claim 1 of the instant application cites a method of making an irrigation hose comprising steps of: extruding a substrate at a first temperature, extruding a continuous flow path, extruding a hose, and connecting the continuous strip to the inner wall, which are fully disclosed in claim 5 of the '768 application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> ((e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

> applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-3, 11-13 are rejected under 35 U.S.C. 102(e) as being unpatentable over Harrold (2005/0258279) with support from Harrold et al. (US 6120634).

Harrold '279 discloses a method of making a continuous self-contained flow path for use in making an irrigation hose at a first location, comprising steps of: extruding a continuous flow path 18a, the flow path having a bottom member and a plurality of features 32, 36, 38, 40, the features operatively connected on top of the bottom member (figure 2), the features including water inlets, flow-regulating members and outlets (paragraph 26); and extruding a continuous strip member 45 onto the features thereby enclosing the flow path and forming a self-contained flow path unit. Harrold '279 states that additional processing of the self contained flow path unit occurs, and that said additional processing is disclosed in Harrold '634. Harrold '634 discloses additional processing of a flow path unit, said additional processing including accumulating the flow path unit and storing the flow path unit for subsequent use in forming an irrigation hose (column 12, lines 63-65). Harrold '279 discloses the step of extruding the substrate 12 by the method disclosed in Harrold '634. Harrold et al. discloses a method of making an irrigation hose comprising: extruding a substrate 12 from the extruder 50 at a first temperature, and allowing the substrate to cool to a second temperature (rollers 52 and 54 with cooling circuit, see column 7, line 64+); extruding a bead of material 186 on the substrate 12 at transfer roller 208 (see column 11, lines 9+); forming a flow path P_2 having a plurality of emitter units 20/22/24 on the substrate 12, thereby operatively

connecting the flow path P_1 to the substrate 12 to form a continuous strip member 12; extruding a hose 12 having an inner wall at the station E; and operatively connecting the continuous strip member to the inner wall after passing through station E, wherein the substrate has a top surface and a bottom surface and the flow path is extruded on the top surface (as shown in figures 2-4). Harrold '279 discloses a method comprising extruding the continuous flow path 18 onto the substrate 12, thereby operatively connecting the flow path to the substrate (figure 4). Furthermore, the order of the claimed steps does not have support by the specification.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 4 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harrold (2005/0258279) and Harrold et al. (US 6120634).

Harrold '279 and Harrold '634 disclose a method with respect to claims 1 and 3 as discussed above. Harrold '634 further discloses a method wherein the second temperature that the substrate is cooled to is set to a desired temperature by circulating coolant through the cooling rolls. Harrold is silent as to a specific temperature. However, one of ordinary skill in the art would have readily achieved applicant's claimed temperature through routine experimentation. Absent any unexpected results presented by the applicant, it would have been obvious to one of ordinary skill in the art at the time

the invention was made to cool the extruded substrate to a temperature below 160 ^{o}F as such a temperature would have been achieved through routine experimentation.

Harrold '279 and Harrold '634 disclose all the limitations of the claims except for a second temperature of less than 160 ^{0}F. However, with absent of any unexpected results presented by the applicant, it would have been obvious to one of ordinary skill in the art at the time the invention was made to cool the extruded substrate to a temperature below 160 ^{o}F as such a temperature would have been achieved through routine experimentation and also is an obvious matter of design choice.

5. Claims 5, 7, 8, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harrold (2005/0258279) and Harrold et al. (US 6120634) in view of Bertolotti et al.

Harrold '279 and Harrold '634 disclose all the limitations of the claims except for a substrate thickness of 0.002 to 0.020 inches. However, Bertolotti et al. teaches a substrate 13 with 0.01 uniform thickness (see column 8, line 36). Therefore, it would have been obvious to one having ordinary skill in the art to have provided the device of Harrold '279 and Harrold '634 with a substrate thickness of 0.002 to 0.020 inches as suggested by Bertolotti et al. Doing so would provide a flexible and light substrate.

Response to Arguments

6. Applicant's arguments filed April 24, 2009 have been fully considered but they are not persuasive. The Examiner maintaining the nonstatutory double patenting rejection, since no Terminal Disclaimer has been filed. The newly added limitation "extruding a bead of material on the substrate" does not provide a clear understanding

the claimed invention, since there are numbers of material bead are described in the specification and it is not clear as to what bead of material is being claimed. Furthermore, the steps of a)extruding a substrate, b) extruding a bead of material, c) forming a flow path, d) extruding a hose, and e) operatively connecting the continuous strip member are not clearly shown and the order of the claimed steps does not have support by the specification. The Applicant arguments are narrower than the claimed invention, since the claims do not provide the detail steps of: how is the extrusion of a bead material onto an extruded substrate, forming of a flow path, and cooling the substrate on which the secondary flow path is extruded as the Applicant has argued on page 7 of the amendment filed on April 24, 2009.

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dinh Q. Nguyen whose telephone number is 571-272-4907. The examiner can normally be reached on Monday-Thursday 6:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Len Tran can be reached on 571-272-1184. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dinh Q Nguyen/
Primary Examiner, Art Unit 3752

dqn